

REMARKS

I. Status of the Claims

Claims 1-29 are pending in this application and stand rejected. No claims have been added or amended by this Reply.

II. Priority

The Examiner requested Applicant to correct information recited by applicant in the Declaration that was filed on April 27, 2004. This Declaration stated the present application claimed benefit of 60/439,981. A new Declaration has been prepared to properly claim benefit of 60/432,981 that was filed on December 13, 2002, and is filed herewith. Applicant notes that the correct priority information was provided on page of the originally filed specification, paragraph [001], and in the Initial Information Data Sheet filed on December 1, 2003.

III. Rejection under 35 U.S.C. § 102

A. Lagrange et al.

The Examiner rejects claims 1-11, 16-18, and 21-29 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,458,168 to Lagrange et al. ("Lagrange") for the reasons disclosed at pages 3 of the present Office Action. Applicant respectfully traverses this rejection for at least the reasons presented below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (emphasis added). In addition, the reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without

any need for picking, choosing, and combining various disclosures" *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972) (emphasis added). The reference must therefore provide a certain degree of precision with respect to the specific compound claimed.

The present claims recite a composition for dyeing keratin fibers comprising, in a medium suitable for dyeing, at least one polyaldehyde heterocyclic compound and at least one nitrogen compound. See, e.g., claim 1. According to the Examiner, "Lagrange teaches a hair dyeing composition comprising dialdehyde heterocyclic compound of 2,3-thiophene-dicarboxaldehyde that reads on the claimed formula (I), in which R is 5-membered monoheterocyclic ring comprising a sulfur atom as claimed in claims 1-7 and a nitrogen compound . . . that reads on the claimed formula (II) . . ." See Office Action at 3 (citation omitted). Applicants disagree with the Examiner.

Lagrange teaches a composition for dyeing keratin fibers comprising at least one aliphatic cationic amine as defined therein and at least one compound chosen from aldehydes; ketones; quinones; diiminoisoindoline derivatives; and 3-aminoisoindolone derivatives. This at least one compound is defined at length in Lagrange at columns 5 through 10. Aldehydes are one of five possible categories for the second ingredient of Lagrange, and may be mono- or poly-aldehydes and may or may not be heterocyclic. Thus for one of ordinary skill to choose aldehydes would require an inordinate amount of picking and choosing. And even if, for the sake of argument, aldehydes were chosen, the Lagrange specification, at column 5, lines 33-65, defines the aldehydes broadly, i.e., there are hundreds of possibilities for formula (III), and at columns 7 to 8, mentions over 70 preferred aldehydes, many of which are monoaldehydes and many of

which are not heterocyclic. Thus, to reach the present claims from this general disclosure would require improper “picking and choosing.” See *In re Arkley*, 455 F.2d at 587. This is hardly anticipation.

Further, for an anticipation rejection to be proper, a single reference must disclose all of the claimed elements “arranged as in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). This is not the case here. As discussed above, Lagrange does not exactly point one of ordinary skill to choose aldehydes, let alone heterocyclic polyaldehydes. But beyond that, Lagrange also fails to teach the presently claimed combination of the polyaldehyde heterocyclic compound of formula (I) with the specific nitrogen compound of formula (II). The Examiner points to optional basifying agents at the bottom of column 11 to support his rejection. Yet nowhere in Lagrange is it taught or suggested for heterocyclic polyaldehydes (or any aldehydes for that matter) to be used together with specific basifying agents falling within the scope of the present claims. Thus, the reference does not teach all of the claimed elements “arranged as in the claim.”

Further, and also contrary to the mandates of the case law, one of ordinary skill in the art would have had to pick and choose elements from Lagrange to reconstruct the presently claimed invention. Therefore, Lagrange does not anticipate the present claims, and Applicant respectfully requests that the § 102(e) rejection be withdrawn.

B. Javet et al.

The Examiner rejects claims 1-15, 17-21 and 23-29 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,740,128 to Javet et al. (“Javet”) for the reasons

disclosed at pages 3-4 of the present Office Action. Applicant respectfully traverses this rejection for at least the reasons presented below.

As an initial matter, Applicant respectfully submits that Javet is not a proper 102(e) reference. M.P.E.P. § 2136 states:

The prior art date of a reference under 35 U.S.C. 102(e) may be the international filing date if the international filing date was on or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the **English language**.

M.P.E.P. § 2136 (emphasis added).

The international application of Javet was published in German and not in English. Therefore, Javet is not a proper 102(e) reference because it was not published in the English language. *Id.* However, Applicant will address Javet in light of the international application, which, although it was published in German, was published November 15, 2001, prior to the filing date of the present application.

As stated above, a prior art reference must "clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures" *In re Arkley*, 455 F.2d 586, 587, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972) (emphasis added). The reference must therefore provide a certain degree of precision with respect to the specific compound claimed.

The present claims, as noted above, recite a composition for dyeing keratin fibers comprising, in a medium suitable for dyeing, at least one polyaldehyde heterocyclic compound and at least one nitrogen compound. See, e.g., claim 1. According to the

Examiner, Javet teaches a hair dyeing composition comprising a dialdehyde heterocyclic compound of 2,5-thiophene-dicarboxaldehyde and a nitrogen compound of monoethanolamine, wherein the nitrogen compound can be 1,4-diaminobenzene (para-phenylenediamine) as claimed in claims 12-15. See Office Action page 4 (citations omitted). Applicant disagrees with the Examiner.

Javet teaches hair dyeing composition comprising at least one enamine of formula (I) and a second component comprising a carbonyl compound and a primary amine. The carbonyl compounds include aldehydes, even the dialdehyde heterocyclic compound 2,5-thiophene-dicarboxaldehyde relied on by the Examiner. But the only mention of this specific compound is among a laundry-list of suitable carbonyl compounds. *Id.* (citing col. 5, line 27). This exhaustive list discloses over fifty different carbonyl compounds. Thus, to reach the present claims from this lengthy disclosure would again require improper “picking and choosing” to obtain the presently claimed heterocyclic polyaldehyde, not to mention improper “picking and choosing” to use a heterocyclic polyaldehyde in combination with an amine falling within the scope of present formual (II). See *In re Arkley*, 455 F.2d at 587. This is not anticipation. Accordingly, this rejection is in error and Applicant respectfully requests its withdrawal.

IV. Rejection Under 35 U.S.C. § 103

A. Javet et al.

The Examiner has rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Javet for the reasons disclosed at page 4 of the present Office Action. Applicant respectfully traverses this rejection for at least the reasons presented below.

The present rejected claim recites a composition for dyeing keratin fibers comprising, in a medium suitable for dyeing, at least one polyaldehyde heterocyclic compound and at least one nitrogen compound wherein said composition has a pH ranging from 5 to 10. See, e.g., claim 1 and 22. The Examiner concedes that Javet "does not teach the claimed range of the pH of the composition" but alleges that "it would have been obvious to one having ordinary skill in the art . . . to formulate a dyeing composition with the claimed pH range because the reference teaches a dyeing composition having a pH in the range of 6 to 11 which is overlapped with the claimed range." Office Action at 4 (citations omitted). The Examiner further asserts, with respect to claim 22, that "a person of ordinary skill in the art would expect such a composition to have similar properties to those claimed, absent unexpected results." *Id.*

Applicant disagrees. In order to establish a *prima facie* case of obviousness, the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." See *In re Fine*, 837, F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Specifically, the Examiner must meet three basic criteria. Among these is the requirement that there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and that one of ordinary skill would reasonably expect success from such a modification or combination. See M.P.E.P. § 2143. It is not sufficient to merely "find every element of a claimed invention in the prior art [and for] an examiner to use the claimed invention itself as a blue print for piecing together elements Such an approach would be an illogical and inappropriate process by which to determine patentability." *In re Rouffet*, 149 F.3d

1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998) (citations and quotations omitted).

Here, the Examiner appears to using the present claims as a blueprint to find the aspects from the disclosure of Javet which support his rejection, but at the same time hs is ignoring other aspects, such as the enamine compound required by Javet. As discussed above, Javet teaches a dyeing composition containing at least one carbonyl compound and discloses a laundry list of suitable carbonyl compounds. This recitation does not provide any guidance or motivation to choose 2,5-thiophene-dicarboxaldehyde or any specific heterocyclic polyaldehyde. It is Applicant's view that only with improper hindsight could one of ordinary skill in the art have reached the presently claimed invention, including the pH range, from Javet.

Thus, Javet fails to meet the requirements of M.P.E.P. § 2143. Accordingly, Applicant respectfully requests that the § 103(a) rejection be withdrawn.

B. Javet et al. in view of Junino et al.

The Examiner rejects claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Javet in view of Junino et al. (US 4,797,129) ("Junino"), for the reasons disclosed at pages 4-5 of the present Office Action. Applicant respectfully traverses this rejection for at least the reasons presented below.

The present rejected claim recites a composition for dyeing keratin fibers comprising, in a medium suitable for dyeing, at least one polyaldehyde heterocyclic compound and at least one nitrogen compound wherein the at least one nitrogen compound is aqueous ammonia. See, e.g., claim 1, 9 and 16. The Examiner admits that Javet "does not teach aqueous ammonia as a nitrogen compound of the claimed

formula (II)". See Office Action at 5. However, the Examiner states that "Javet suggests the use of alkalizing agents such as ammonium hydroxide for adjusting the pH of the composition." *Id.* (citations omitted). Then, to cure the deficiencies of Javet, the Examiner relies on Junino, arguing that Junino teaches a composition comprising alkalizing agents such as aqueous ammonia and or ammonium carbonate for adjusting the pH of the dyeing composition. *Id.* The Examiner concludes that one having ordinary skill in the art at the time the invention was made would have been motivated to modify the composition of Javet by substituting the ammonium carbonate with the aqueous ammonia as taught by Junino to make such a composition. *Id.*

Applicants disagree with the Examiner. As discussed above, Javet fails as a primary reference. And Junino does not remedy the lack of guidance or motivation to choose 2, 5-thiophene-dicarboxaldehyde in Javet.

Further, the proper legal determination of the obviousness or non-obviousness of a particular combination of the cited references, is whether the references themselves actually suggest the desirability of making the particular combination. *In re Mayne*, 104 F.3d 1339, 1342, 41 U.S.P.Q.2d 1451, 1454 (Fed. Cir. 1987) (quoting *In re Dillon*, 919 F.2d 688, 16 U.S.P.Q.2d 1897 (Fed. Cir. 1990)). Here, without further guidance or selection criteria, Javet's laundry list of possible carbonyl compounds and Junino's teaching of aqueous ammonium do not form the basis of suggestion or motivation to one skilled in the art to select 2, 5-thiophene-dicarboxaldehyde as an aldehyde component and/or (2) to use aqueous ammonium as the nitrogen component with any reasonable expectation of success.

Thus, for at least the foregoing reasons, Applicant respectfully submits that the rejections under 35 U.S.C. § 103 are in error and should be withdrawn.

CONCLUSION

Applicant therefore respectfully requests reconsideration of this application in view of the foregoing amendments and remarks, and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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